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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

FLETCHER, JAMES A

ART UNIT PAPER NUMBER

2616

DATE MAILED: 06/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/865,970

Applicant(s)

LU, BIN

Examiner

James A. Fletcher

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-39 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1, 3, 5-10, 12-16, 18-19, 21-25, 27-31, 33, and 35-39 are rejected under 35 U.S.C. 102(e) as being anticipated by Bonomi et al (6,769,127).

Regarding claims 1, 16, and 31, Bonomi et al disclose a method and a computer readable medium having computer readable code embodied therein for performing the method comprising:

- a server computer receiving a first request from a first receiver device for a television show (Col 9, lines 36-37 “some of the subscribers may request a part of whole of the programs be recorded”);
- the server computer locating a digital video recorder capable of receiving a broadcast of the television show that satisfies the first request (Col 6, lines 50-58 “the delivery agent 104 includes a receiver which receives television signals...the delivery agent 104 can include an encoder that digitizes the TV signals and converts the digitized TV signals to a digital format so that the signals can be further processed, stored, and redelivered via a network 108”);
- the digital video recorder receiving a programming instruction from the server computer to record the television show when broadcast by a television content provider, after the server computer locating the digital video recorder (Col 19, lines 42-45 “The media content to be recorded by the record content module 510 can be the media content associated with a pause or record request issued by a subscriber”);
- the digital video recorder recording the television show during broadcast of the television show by the television content provider, after the digital video recorder receiving the programming instruction (Col 6, lines 50-58 “the delivery agent 104 includes a receiver which receives television signals...the delivery agent 104 can include an encoder that digitizes the TV signals and converts the digitized TV signals to a digital format so that the signals can be further processed, stored, and redelivered via a network 108”); and

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- the first receiver device receiving the television show recorded by the digital video recorder (Col 7, lines 16-17 “the terminal device 110 can receive video services provided by the server 106”).

Regarding claims 3, 18, and 33, Bonomi et al disclose a method comprising the first receiver device receiving an electronic programming guide from the server computer (Col 18, lines 22-25 “the program guide 520 is implemented with a markup language and is downloaded to a client machine for display and updated at predefined times”).

Regarding claims 5 and 19, Bonomi et al disclose a method wherein the programming instruction comprises an Internet Protocol address of the first receiver device (Col 24, lines 46-47 “the VNP has an identifier [ID], an IP address, and a port number”).

Regarding claims 6 and 21, Bonomi et al disclose a method comprising the first receiver device transmitting a television show search topic to the server computer (Col 34, lines 62-64 “The screen 1507 includes an entry area 1550 that allows a viewer to enter his/her preferences 1551 to facilitate a search in one or more channels”).

Regarding claims 7 and 22, Bonomi et al disclose a method wherein the first receiver device, server computer, and digital video recorder are coupled via the Internet (Col 6, lines 59-62 “when the media source 102 is a network video resource over a data network [e.g., the Internet], the delivery agent 104 may be simply part of the data network” and Col 7, lines 9-12 “The network 108 couples the server 106 to a terminal device 110. The network 108...can be part of a larger network including the Internet”).

Regarding claims 8, 23, and 35, Bonomi et al disclose a method wherein the first receiver device comprises a television Internet box (Col 11, lines 56-57 The VNP [video network platform] device 330 may correspond to any one of the VNP devices in FIG. 3A”).

Regarding claims 9, 10, 24, 25, 36, and 37, Bonomi et al disclose a method wherein the first receiver device comprises a computer or a set-top-box (Col 7, lines 21-23 “Examples of the terminal device 110 may include a desktop computer, a laptop or notebook computer, a set-top box, and a mobile device.”).

Regarding claims 12, 27, and 38, Bonomi et al disclose a comprising the step of the digital video recorder transmitting the television show recorded by it to the first receiver device (Col 8, lines 47-49 “The media content stored in the media storage device 206 can be streamed or delivered to subscribers over the network by media delivery hardware 206”).

Regarding claims 13, 28, and 39, Bonomi et al disclose a method comprising the step of the server computer receiving the television show recorded by the digital video recorder (Col 9, lines 5-9 “The media storage device 206 facilitates the operations of the media delivery center by providing storage space to cache or store the video sources received from the media receiving unit 202”) and transmitting it to the first receiver device (Col 8, lines 47-49 “The media content stored in the media storage device 206 can be streamed or delivered to subscribers over the network by media delivery hardware 206”).

Regarding claims 14 and 29, Bonomi et al disclose a method comprising the steps of:

- a cache server computer receiving and storing the television show recorded by the digital video recorder (Col 9, lines 5-9 "The media storage device 206 facilitates the operations of the media delivery center by providing storage space to cache or store the video sources received from the media receiving unit 202"); and
- the cache server transmitting a first copy of the television show recorded by the digital video recorder to the first receiver device (Col 8, lines 47-49 "The media content stored in the media storage device 206 can be streamed or delivered to subscribers over the network by media delivery hardware 206").

Regarding claims 15 and 30, Bonomi et al disclose a method comprising, in response to the server computer receiving a second request from a second receiver device for the television show, the cache server transmitting a second copy of the television show recorded by the digital video recorder to the second receiver device (Col 20, lines 46-49 "only one recorded copy is retained in the storage device while multiple copies at different intervals can be provided to subscribers").

4. Claims 2, 17, and 32 are rejected under 35 U.S.C. 102(e) as being anticipated by Cao et al (application 09/586247, incorporated by reference in Bonomi, Col 1, lines 28-33).

Regarding claims 2, 17, and 32, Cao et al disclose a method comprising the digital video recorder adding the programming instruction to its programmable task list

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(Page 15, lines 14-16 "When a decision 512 determines that the requested program is not already scheduled for recording, then the recording of the requested program is scheduled 516").

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 11 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bonomi as applied to claims above.

Regarding claims 11 and 26, Bonomi et al disclose a method wherein the first receiver device comprises a second video recorder (Col 13, line 64 "an architecture 360 of a VNP device" and Col 14, lines 24-26 "The VTR driver 373, together with the VTR engine 3745, is used to communicate with a video recording device"), but do not specifically disclose that the video recorder is digital.

The examiner takes official notice that digital video recorders are well known, commercially available, and widely used devices for the recording of video signals, providing acceptable quality, long-term storage, and convenience of use.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Bonomi in order to specify a digital video recorder as an embodiment of the first receiver device.

7. Claims 4, 20, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bonomi as applied to claims above, and further in view of Grooters (6,684,399).

Regarding claims 4, 20, and 34, Bonomi et al disclose a program guide that includes a large amount of programming (Col 18, lines 25-26 "The program guide 520 originally lists all the channels being serviced by the media delivery center"), but does not disclose that it shows worldwide programming.

Grooters teaches a method wherein the programming guide comprises worldwide television programming (Col 1, lines 61-65 "The first information handling system is configured to search a worldwide network for information regarding a transitory broadcast event and to incorporate the transitory event information into the generated program guide").

As taught by Grooters, a worldwide programming guide is well known, widely used, and commercially available, and provides a user with a complete selection of programming available to him or her.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Bonomi et al in order to provide the user with a world-wide program guide.

The examiner would like to note that the above rejections are based on the interpretation of the broadly written claims 1, 16, and 31 wherein the server computer and the digital video recorder are co-located. An amendment that clarified the claims to note that the server and the digital video recorder are remote from each other would overcome the cited reference.

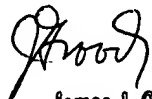
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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A. Fletcher whose telephone number is (571) 272-7377. The examiner can normally be reached on 7:45-5:45 M-Th, first Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Groody can be reached on (571) 272-7950. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JAF
23 May 2005


James J. Groody
Supervisory Patent Examiner
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